REMARKS

Reconsideration of the present application is respectfully requested.

As indicated in the office action, claims 25-51 are pending in the application. Claims 1-24 have been canceled.

Regarding the rejection of claims 25, 27-28, 34-35, 38, 42, 44-45, and 48 on double patenting grounds, the applicants believe that this rejection should not stand. U.S. Patent no. 6,423,148, part of the basis for the double-patenting rejection, is indicated by the examiner as purportedly reciting all limitations of the invention claimed by the applicants, with the exception of the ammonia concentration. Realizing that the claims of the '148 patent are insufficient as a basis for finding obviousness of the invention as presently claimed, the examiner relies upon Jiang et al. U.S. Patent No. 6,277,203 ("Jiang '203") to purportedly supply the missing teaching, namely, the ammonia concentration of the claimed invention.[1] However, it is the applicant's position, supported by legal authority, that it is impermissible in a double patenting rejection to rely upon the teachings of a secondary reference to cure the deficiencies of the primary reference. A double patenting rejection is proper only where the *claims* of an application are obvious (or lack novelty) in view of the *claims* of a patent or patent application. See MPEP. § 804 pp. 800-22, where it is stated:

> "In determining whether a nonstatutory basis exists for a double patenting rejections, the first question to be asked is –does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? If the answer is yes, then an "obviousness-type" nonstatutory double

[1] The office action states that it would have been obvious at the time applicant invented the claimed process to utilize ammonia at low concentration as disclosed by Jiang et al in the process of '148 patent for the purpose of enhancing the particle removal as disclosed by Jiang et al. Office Action at page 3.

> patenting rejection may be appropriate. Obviousness-type double patenting requires rejection of an application claim when the **claimed subject matter is not patentably distinct from the subject matter claimed** in a commonly owned patent when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. See *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 9555, 58 USPQ2d 1865 (Fed. Cir 2001); *Ex parte Davis*, 56 USPQ2d 1434, 1435-36 (Bd. Pat. App. & Inter. 2000) (Emphasis added)

Also, based upon the previous passage, we note that the rationale behind a double patenting rejection does not apply here. The present application has a U.S. filing date *earlier* than the '148 patent, and accordingly, any patent issuing on the present application would expire prior to the '148 patent expiration. Thus, there should be no concern in this case over "unjustified extension" of the patent term. Accordingly, the double patenting rejection is improper in the applicants' view.

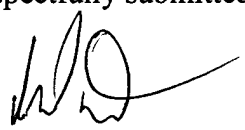
In any event, Jiang '203 is not prior art with respect to the present application. Submitted herewith is a certified English-language translation of Japanese Patent Application No. Heisei 10-138365, filed on May 20, 1998, the application from which the present application claims priority pursuant to 35 U.S.C. § 119. The filing date of JP Hesei 10-138365 is earlier in time than the earliest U.S. filing date of Jiang '203. Accordingly, reliance on Jiang '203 is inappropriate and it is submitted that the rejection is traversed for this second reason.

Claims 25, 27-28, 34-35, 38, 41-42, 44-45, 48 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ilardi et al. in view of Jiang et al. It is submitted that the rejection of the claims based on Ilardi (U.S. Patent no. 5,498,293) in view of Jiang '203 cannot stand since as noted above, Jiang '203 is not prior art with respect to the present application. In any event,

Ilardi does not appear to teach a method employing a *two-step* washing process. Specifically, polycarboxylic acids are disclosed as being a potential additional component to a cleaning solution, not as a second treating solution. Thus, Ilardi simply does not teach a two-step process. Also see, the examples of Ilardi concerning same.

Wherefore, based upon the foregoing, it is respectfully submitted that the present application is in condition of allowance and a relatively early reply to this paper would be appreciated.

Respectfully submitted,



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